

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :  
Brian L. Jackson et al. : Group Art Unit: 3623  
Appln. No.: 10/033,943 : Examiner: Romain Jeanty  
Filed: December 28, 2001 : Confirmation No.: 8965  
For: COMPLIANCE MANAGEMENT : Customer No.: 21967  
SYSTEM AND METHOD :  
:

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicant hereby requests a pre-appeal brief conference in the above-referenced patent application.

The present patent application was filed on December 28, 2001. On March 15, 2006, an initial Office Action was issued objecting to claims 4, 7 and 31 for formalities, rejecting claim 1 and dependents 2-23 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, rejecting claims 1-6, 24-28, and 38-41 under 35 U.S.C. § 102(b) as being anticipated by Sturgeon et al. (U.S. Patent No. 5,726,884) and rejecting claims 7-23 and 29-37 under 35 U.S.C. § 103(a) as being unpatentable over Sturgeon et al. (U.S. Patent No. 5,726,884) in view of Dialog (Santa Fe Pacific Corp.). On June 15, 2006, a response was filed amending claims 4, 7 and 31 to cure the objection to the informalities and presenting arguments for the objections. On September 8, 2006, a Final Office Action was issued acknowledging that the Applicant overcame the objections to 4, 7 and 31, acknowledging the Applicant overcame the 35 U.S.C. 112 objections to claim 1 and its dependents, and maintaining the rejections of claims 1-6, 24-28, and 38-41 under 35 U.S.C. § 102(b) as being anticipated by Sturgeon et al. (U.S. Patent No. 5,726,884) and the rejections of claims 7-23 and 29-37 under 35 U.S.C. § 103(a) as being unpatentable over Sturgeon et al. (U.S. Patent No.

5,726,884) ("Sturgeon") in view of Dialog (Santa Fe Pacific Corp). On November 8, 2006, a response was filed presenting arguments addressing the rejections. On December 4, 2006, an Advisory Action was issued maintaining the rejection of claims 1-41.

Thus, despite repeated attempts to convince the Examiner that the cited references clearly fail to disclose, or even suggest, the claimed invention, the Office has maintained its rejection of claims 1-41, which is certain to be overturned on appeal. Rather than spending further time reiterating the same arguments clearly establishing that the cited reference fails to disclose, or even suggest, the claimed invention, Applicant has elected to pursue the new pilot program.

As set forth in greater detail in Applicant's responses dated June 15, 2006, and November 8, 2006, the cited references fail to disclose, or even suggest, the claimed invention. Specifically, regarding claims 1, 24, 28, and 38, the Examiner asserts that Sturgeon discloses the claimed inventions.

First, the Examiner asserts that Sturgeon et al. discloses scheduling a resource to respond to a compliance event, as claimed. The Examiner, in response to earlier arguments, cites to column 15, line 44 - column 16, line 16. The language cited by the Examiner refers to a hazardous commitment manager ("HCM") functional grouping. "A user may utilize the HCM grouping 61 to build a safety inspection schedule for periodic (date specific) inspection of fire extinguishers, eye wash stations and decontamination systems for employee work stations." column 15, lines 55-60. Sturgeon, as cited by the Examiner, also discusses "statements of emergency response plans for different classes of emergency releases ... [and] emergency equipment that may be needed to respond to an emergency release... ." column 15, line 63 - column 16, line 1. Thus, Sturgeon, at best, allows for the creation of commitments on particular periodic dates and allows for the creation of emergency response plans. Sturgeon does not discuss the scheduling of resources for its commitments. Furthermore, it is clear that emergency response plans do not constitute a scheduling of resources. Emergencies by their very nature are not planned or scheduled, nor does Sturgeon disclose such resource scheduling. At best, Sturgeon discloses the preparation of a plan that lists resources which may be available in the event of an emergency.

In contrast, claims 1, 24, 28, and 38 recite scheduling an appropriate resource to respond to a particular compliance event

(e.g., a natural gas line repair, service, inspection, follow-up, etc.). Nowhere does Sturgeon et al. disclose, or even suggest, such a feature. Sturgeon's discussion of commitments is best understood as creating commitments for periodic inspections. Sturgeon does not discuss allocating resources for these inspections. Accordingly, it is respectfully submitted that Sturgeon et al. fails to disclose, or even suggest, this claimed feature.

It is respectfully submitted that Sturgeon et al. also fails to disclose, or even suggest, a computer system including a main computer and a remote computer adapted to communicate with the main computer, at least a portion of a main program and the database accessible by the main computer, the remote computer accessing a remote program operative to display and modify only a remote portion of the plurality of compliance events and only a remote portion of the plurality of resources of the database, as claimed. The Examiner points to column 10, lines 39-60, of Sturgeon et al. for a teaching of this claimed feature. However, nowhere in this particular section, or any section, of Sturgeon et al. is this claimed feature disclosed. In contrast, Sturgeon et al. merely discloses dynamic links between functional groupings, which is hardly a teaching of this claimed feature.

The Examiner, in response to earlier arguments, cites to column 23, line 60 - column 24, line 55. The portion cited by the Examiner discusses material safety data sheets (MSDS) and various screens displaying the location of waste and facility information. The system disclosed by Sturgeon can store information about remote locations and facilities, but there is no disclosure or suggestion that the system contemplates working with a remote computer adapted to communicate with a main computer. A system which contains information about other locations does not disclose or suggest a:

remote computer adapted to communicate with the main computer, at least a portion of a main program and the database accessible by the main computer, the remote computer accessing a remote program operative to display and modify only a remote portion of the plurality of compliance events and only a remote portion of the plurality of resources of the database,

as required by claim 1 or the similar limitations in claims 24 and 28. Accordingly, it is respectfully submitted that Sturgeon

et al. also fails to disclose, or even suggest, this claimed feature.

It is respectfully submitted that Sturgeon et al. further fails to disclose, or even suggest, periodically scanning a database to identify at least one of a plurality of compliance events requiring a response, and scanning the database to identify at least one of a plurality of resources to respond to the compliance event requiring the response, as claimed. The Examiner points to column 49, lines 35-61, of Sturgeon et al. for a teaching of this claimed feature. However, nowhere in this particular section, or any section, of Sturgeon et al. is this claimed feature disclosed. In contrast, Sturgeon et al. merely discloses identifying an appropriate person to respond to some future "unplanned" release of hazardous material. Such an "unplanned" event is much different than a current compliance event requiring a response. Accordingly, it is respectfully submitted that Sturgeon et al. also fails to disclose, or even suggest, this claimed feature.

In view of the foregoing, it is respectfully submitted that Sturgeon et al. does not disclose, or even suggest, the limitations of claims 1, 24, 28, and 38. Accordingly, it is respectfully submitted that claims 1, 24, 28, and 38 should be allowable over Sturgeon et al..

Regarding claims 2-6, 25-27, and 39-41, these claims are dependent upon independent claims 1, 24, and 38. Thus, since independent claims 1, 24, and 38 should be allowable as discussed above, claims 2-6, 25-27, and 39-41 should also be allowable at least by virtue of their dependency on independent claims 1, 24, and 38. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-6, 24-28, and 38-41 be withdrawn.

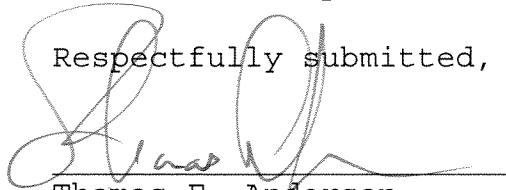
On pages 6-9 of the Office Action, claims 7-23 and 29-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sturgeon et al. (U.S. Patent No. 5,726,884) in view of Dialog (Santa Fe Pacific Corp.). This rejection is hereby respectfully traversed.

Regarding claims 7-23 and 29-37, these claims are dependent upon independent claims 1 and 28. Thus, since independent

claims 1 and 28 should be allowable as discussed above, claims 7-23 and 29-37 should also be allowable at least by virtue of their dependency on independent claims 1 and 28. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully submitted that the aforementioned rejection of claims 1-41 is in error. Accordingly, for the foregoing reasons, Applicant requests that a pre-appeal brief conference be convened so as to advise Applicant as to whether the Office will: 1) allow the present claims; 2) reopen prosecution and issue a new office action; or 3) allow this case to proceed to appeal.

Please charge any shortage in fees due in connection with the filing of this communication to Deposit Account No. 50-0206, and please credit any excess fees to such deposit account.

  
Respectfully submitted,  
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Date: December 8, 2006